

REMARKS

I. Status of the Application

In view of the following remarks, reconsideration of the rejections set forth in the Office Action of April 19, 2011 is respectfully requested.

II. Prior Art Rejections

Claims 4-10, 15, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka (JP 2000-266144) in view of Sirven (US 4,749,068) in view of Homme (US 5,178,239) and further in view of Mizumukai (US 4,561,524), claims 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Sirven in view of Homme in view of Mizumukai and further in view of Rossman (US 2,087,451), claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Sirven in view of Homme in view of Mizumukai and further in view of Orloff (US 2,564,790).

At the top of page 4 of the Office Action, the Examiner acknowledges that the Tanaka reference does not disclose a return chamber or a relief valve as required by claim 4. However, it is asserted that modifying the Tanaka reference to have the control valve (41) and radial passages (49) of Sirven would yield the claimed invention and would have been obvious to one skilled in the art at the time the invention was made.

In the response of February 28, 2011, the Applicant provided detailed remarks explaining why the combination of the Tanaka and Sirven references would not have been obvious. The Examiner responds by asserting “the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).” (See page 10 of the Office Action of April 19, 2011).

The issue in the present application does not involve advantages “which would flow naturally from following the suggestion of the prior art.” Quite the contrary, the Examiner’s assertion of obviousness in the present application is incorrect specifically because:

- A. there is no suggestion in the prior art to modify the valve (41) of Sirven to perform a new function which is not disclosed in Sirven or elsewhere in the prior art; and
- B. there are no advantages which flow naturally from incorporating an unmodified valve (41) of Sirven into the device of Tanaka.

These two issues are addressed in turn below with reference to applicable law and the disclosures of the prior art.

A rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Thus, while the analysis under 35 U.S.C. 103 allows flexibility in determining whether a claimed invention would have been obvious, it still requires showing that “there was an apparent reason to combine the known elements in the fashion claimed by the patent [or application] at issue.” *Id.* (emphasis added). The obviousness analysis “should be made explicit,” and it “can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* (emphasis added).

As mentioned in the response of the February 28, 2011, the control valve (41) of the Sirven reference serves to regulate the speed at which the rod (3) moves during the normal operation of the shock absorber (see column 7, lines 3-19 of Sirven). The Examiner asserts that

one skilled in the art would have provided the valve (41) of Sirven in the device of Tanaka “to allow the auto-tensioner to be compressed quickly under a large force to prevent damage to itself or to the belt drive system.” However, such a protective operation is not performed by the valve (41) of Sirven. The Examiner apparently concedes all of the above, because it is stated on page 10 of the Office Action that “the shock absorber would still be movable even if the relief valve requires a large force to open,” i.e. even if the valve (41) of Sirven were modified. However, a determination of obviousness requires an identification of the reason that would prompt one skilled in the art to modify the valve (41) of Sirven to have the function proposed by the Examiner, which is a function not disclosed in Sirven and not disclosed elsewhere in the prior art. As cited above, applicable law requires that a determination of obviousness include a rational underpinning and an identification of an apparent reason to combine prior art elements in the manner set forth in the claim. The assertion of obviousness in the present application does not identify any suggestion in the prior art or explain any rational underpinning which would have led one skilled in the art to modify the valve (41) of Sirven to function in a way which is not disclosed in the Sirven reference; as such, the determination of obviousness is deficient, and withdrawal of the prior art rejection is respectfully requested.

Furthermore, there would be no advantage to providing the unmodified valve (41) of Sirven into the device of Tanaka. Referring to figure 1 of Sirven, it can be seen that moving the piston rod (3) into the chamber (2) would increase the volume of the piston rod (3) which is disposed in the chamber (2). Such an increase would cause pressure in the chamber (2) to increase, which causes the nonreturn valve (31) to close. As such, the control valve (41) must open to allow the rod (3) to move upward by even a small amount; if the control valve (41) is not opened, fluid cannot be displaced from the chamber (2) and thus the shock absorber cannot

accept any increase in the volume of the piston rod (3) in the chamber (2). This is true regardless of the fact that fluid can flow from chamber portion (2a) to chamber portion (2b) through the passage (28). In view of the above, it is clear that the valve (41) of Sirven is not a relief valve at all, but instead is a proportional valve that opens to allow even small movements of the piston rod (3). There would have been no reason to provide such a valve into the apparatus of Tanaka, and thus withdrawal of the obviousness rejection is respectfully requested.

Claims 5-18 depend, directly or indirectly, from claim 4 and are thus allowable over the applied prior art for at least the reasons set forth above in support of claim 4.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, it is respectfully submitted that the present application is now in condition for allowance, and action to such effect is earnestly solicited. If any issues remain after consideration of the response, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

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